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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/196,524    11/20/98    JESSOP    P    3517.1

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EXAMINER

HANDY, D

ART UNIT

PAPER NUMBER

1743

DATE MAILED:

10  
12/06/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
09/196,524

Applicant(s)  
Jessop et al.

Examiner  
Dwayne K. Handy

Group Art Unit  
1743



☒ Responsive to communication(s) filed on Sep 25, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

☒ Claim(s) 2-4 and 6-8 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 2-4 and 6-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration was previously objected to as defective. In light of applicant's submission of a substitute declaration providing the address of Mr. Timpson, the rejection is removed.

### ***Claim Objections***

2. Claim 8 is objected to because of the following informalities: Claim 8 recites that the "plurality of extensions includes an extension for positioning into each pipette tip on the receiving card". Although the Examiner believes that applicant is trying to claim "an extension of the original extension (a further extension , maybe?), it is unclear due to the language of the claim if this indeed the case. Rather than reject the claim as unclear, it was objected to as a minor informality. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 2-4 and 6-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 2, lines 14-15, applicant has recited a limitation on the transfer member of the system which states that "said transfer member being a plate with an upper surface and with an undersurface having *only* a plurality of extensions extending from said undersurface..." This negative limitation is not disclosed in the specification however. In describing the transfer member - page 7 - applicant merely states that a "plurality of projections or bosses 34 are attached to a bottom surface 31 of rectangular plate 32...". Later in the same paragraph, applicant states that some of the bosses may be eliminated to save costs, but nowhere does the specification state that the transfer member is to contain *only* the extensions/bosses. Therefore, the Examiner contends that applicant has not disclosed this limitation and amending the claim to include it constitutes the addition of new matter.

5. Claims 4 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, applicant recites the limitation that the spacing distance is "less than distance from the first joint of the user's thumb and the tip of the user's thumb." This is indefinite. Applicant has placed a limitation on the device that is defined by an unknown

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quantity. That is, since the user of the device is unknown (and could be anyone), the spacing distance of the system cannot be defined by the length of the user's appendages.

### *Inventorship*

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scaramella et al. Scaramella et al. shows a system for positioning pipette tips in a dispensing tray which has a receiving plate (Figures 1 and 8, element #22) with a plurality of apertures sized for pipette tips and the apertures arranged to correspond to openings in an upper wall of a dispensing tray. Scaramella also shows a transfer member (Figure 4, #29) for engaging the pipette tips with an under surface not connected to the receiving plate. The transfer member has a plurality of projections extending from the under surface, with the projections arranged to correspond to receiving plate apertures, sized to fit a top opening of each pipette and for holding the pipette tip in alignment for positioning through the openings of the dispensing tray. The Examiner agrees with/notes applicant's assertion (Applicant's Remarks filed 9/20/00) that Scaramella's transfer member does not have the locking means of Scaramella. It would be obvious to one of ordinary skill in the art, however, that the device of Scaramella could exclude the locking means and still operate as a pipette transfer device. Also, the courts have held that omission of an element with a

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corresponding omission of function is within the level of ordinary skill in the art (*In re Wilson* 153 USPQ 740; *In re Larson* 144 USPQ 347; *In re Karlson* 136 USPQ 184; *In re Portz* 145 USPQ 397; *In re Liston* 58 USPQ 481; *In re Porter* 20 USPQ 298.). In this case, the element would be the locking means.

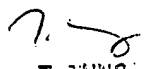
**Conclusion**

10. The Examiner would like to point out that due to the new grounds of rejection and the fact that several of the claims had not been examined, this rejection has NOT been made final.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (703)-305-0211.

dkh

December 4, 2000

  
T. TUNG  
PRIMARY PATENT EXAMINER  
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